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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/731,900

12/09/2003

Brian Jones

60001.0276US01/MS304207.1

4709

7590

05/12/2006

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EXAMINER

VAUGHN, GREGORY J

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,900

Applicant(s)

JONES ET AL.

Examiner

Gregory J. Vaughn

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2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/9/05 & 9/21/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Action Background

1. This action is responsive to the application filing, application filed on 12/9/2003.
2. Claims 1-20 are pending in the case, claims 1, 11 and 14 are independent claims.
3. Acknowledgement is made to the applicant's submission of two Information Disclosure Statements, filed 6/9/2005 and 9/21/2005.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:
 - "26" in Figure 1.
 - "240" in Figure 2.
 - "335" and "360" in Figure 3.
 - "445" and "450" in Figure 4.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:
- The disclosure fails to disclose those reference signs listed in paragraph 4 above, which are shown in the drawings.

Appropriate correction is required.

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:
- "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."*
8. Claims 1-3, 5-10, 14 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
9. **Regarding claims 1-3, 5-10, 14 and 20**, the claimed invention fails to produce a useful, concrete or tangible result. The claimed invention as a whole must accomplish a practical application. That is, it must produce a *"useful, concrete and tangible result."* *State Street*, 149 F.3d at 1373, 47

USPQ2d at 1601-02. (See MPEP 2106.) Usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459.

Applicant's invention is directed toward inserting a portion of text or data into a document where the inserted portion of text or data carries with it its own specific formatting properties. Applicant's claims describe the steps taken to manipulate (i.e. selecting, applying data, applying XML markup, inserting, parsing, determining and associating) the non-functional descriptive material (i.e. the portion of text), but fail to describe a significant functionality for the processed portion of text. However, the specification and claims 4, 11-13 and 15-19 include a displaying step, which provides a significant functionality (i.e. presenting to a user), which is statutory under 35 USC 101.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

11. Claims 1-4, 10, 11, 13-15 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Takizawa et al. US Patent Publication 2004/0019853, filed 7/17/2003, published 1/29/2004 (hereinafter Takizawa).
12. **Regarding independent claim 1**, Takizawa discloses selecting text from a first document for use in a second document. Takizawa discloses selecting a first portion of text in a first document. Takizawa recites: *"FIG. 5B is an explanatory view showing a screen in selecting "transition of stock price" from the list of contents"* (paragraph 27). Takizawa discloses applying data to the selection of text and applying XML markup to the selection of text for formatting apart from any data applied to the text in the first or subsequent documents. Takizawa recites: *"When the selection operation is completed, menu data selected by the client (in this case, data indicating the type of the*

filing document) is transferred, and contents list data (contents list generation information) of the corresponding filing company data (XML format data) is extracted based on judgment of the management program" (paragraph 101).

13. **Regarding dependent claim 2**, Takizawa discloses inserting the selected text into a second document, and parsing the second document for data required for the second document after inserting the selected text. Takizawa recites: "*When the recognizing of the specific data is possible, it is first possible to designate "to insert the table after this sentence" or "to insert the sentence before the table" (paragraph 114).*

14. **Regarding dependent claim 3**, Takizawa discloses determining the data applied to the selected text from the first document. Takizawa recites: "*When the selection operation is completed, menu data selected by the client (in this case, data indicating the type of the filing document) is transferred, and contents list data (contents list generation information) of the corresponding filing company data (XML format data) is extracted based on judgment of the management program" (paragraph 101).*

15. **Regarding dependent claim 4**, Takizawa discloses applying the data applied to the selection of text in the first document to the selection of text in the second document. Takizawa recites: "*an editing management function portion which edits document data (XML) based on predetermined information input from the client terminal via the server; a data conversion function portion (XSLT, CSS) which converts the data format for use in the*

client terminal so as to match the data format with the format of the document data" (paragraph 21). Takizawa discloses displaying the second document with the inserted text having the formatting preserved from the first document. Takizawa recites: *"Additionally, since the extracted contents list data has the XML format, the data cannot correctly be displayed/output in the browser present on the client side as such. Therefore, here XSLT (i.e., software which converts XSL as a style sheet description language for XML) is used to convert the contents list data of the XML format into the HTML format. Thereafter, the contents list data converted into the HTML format, and client processing software are sent to any one of the client terminals 14, 16, 18, 20 on the client side from the server 12. Moreover, the contents list data is displayed in a format shown in (start screen: FIG. 5A) (Step 4)"* (paragraph 102).

16. **Regarding dependent claim 10**, Takizawa discloses associating the selected text with an XML schema file for providing a definition of the XML markup and parsing rules for understanding the xml tags. Takizawa recites: *"an editing management function portion which edits document data (XML) based on predetermined information input from the client terminal via the server; a data conversion function portion (XSLT, CSS) which converts the data format for use in the client terminal so as to match the data format with the format of the document data"* (paragraph 21).

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17. **Regarding independent claim 11**, the claim is substantially the same as claims 1-4 combined, and is rejected using the same rationale.
18. **Regarding dependent claim 13**, the claim is substantially the same as claim 10, and is rejected using the same rationale.
19. **Regarding independent claim 14**, the claim is directed toward a computer-readable medium for the method of claim 1, and is rejected using the same rationale.
20. **Regarding dependent claim 15**, the claim is directed toward a computer-readable medium for the method of claims 2-4 combined, and is rejected using the same rationale.
21. **Regarding dependent claim 12**, the claim is substantially the same as claim 10, and is rejected using the same rationale.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 5-9, 12 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takizawa.

24. **Regarding dependent claims 5 and 6**, Takizawa anticipates parsing the second document with the selected/inserted text according to the data (claim 5) so that the text is formatted according to the data applied to the text in the first document (claim 6). Takizawa recites: "*conversion means (data conversion function portion 12c of the authoring management program (CSS, XSLT, XML parser, DOM)) for converting the XML format data edited by the editing means into the HTML format data (i.e., data format for use in the terminal devices 14, 16, 18, 20 on the client side)*" (paragraph 84). Takizawa's invention takes text from an XML document and converts into text for an HTML document, where the formatting is maintained after the text is inserted. Takizawa fails to disclose the second document as XML, however XML and HTML are both markup languages, where tags are used to handle formatting, and a parser processes the markup language to produce a displayable

document. Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to maintain formatting characteristics of a portion of text that was inserted into an XML document, in order to provide a duplicated look of the text as was in the original document.

25. **Regarding dependent claims 7-9**, Takizawa anticipates adding a tag to selected text to indicated the formatting (claim 7), where the formatting is the same as in the first document (claim 8), and where the tag used is a `<cfChunk>` tag (claim 9). Takizawa recites: *"The display information changing section 101 receives the identification information indicating an item constituting an edition object, which is transmitted from a client computer, and edit information indicating an edition content of the item constituting the edition object. Moreover, the section uses the received identification information as a key to acquire the display information of the XML format from the matching list 12e, and changes the acquired display information of the XML format so as to obtain the edition content indicated by the received edit information"* (paragraph 136). While Takizawa uses an indicator, Takizawa fails to describe the indicator as a tag, or that the tag would be given a specific value. However, formatting indicators in markup language documents take the form of tags. Furthermore, applicant's disclosure teaches that: *"the element <cfChunk> is illustrative of an infinite number of names that could be provided to the element"* (page 22, lines 18-19 of the originally filed disclosure), and hence would have been obvious to use any tag name to indicate the inserted text. Therefore, it would have been obvious, to one of

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ordinary skill in the art, at the time the invention was made, to use an indication, as taught by Takizawa, in the form of a tag, because tags are used in markup language documents to indicated formatting characteristics.

26. **Regarding dependent claim 12**, the claim is substantially the same as claim 9, and is rejected using the same rationale.

27. **Regarding dependent claims 16-19**, the claims are directed toward a computer-readable medium for the method of claims 5-8, and are rejected using the same rationale.


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Conclusion

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory J. Vaughn
May 10, 2006